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June 10, 2002

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Commissioner for Patents  
Washington, D.C. 20231

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JUN 14 2002

TECH CENTER 1600/2900

Art Unit 1632

Re: U.S. Utility Patent Application  
Appl. No. 09/653,277; Filed: August 31, 2000  
For: **Cell-Specific and/or Tumor Specific Promoter Retargeting of Herpes  
Gamma 34.5 Gene Expression**  
Inventors: Chiocca and Chung  
Our Ref: 0609.4880002/JAG/KRM

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Reply to Restriction Requirement; and
2. Return postcard.

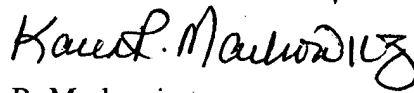
It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents  
June 10, 2002  
Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Karen R. Markowicz  
Agent for Applicants  
Registration No. 36,351

KRM/pcd  
Enclosures

SKGF\_DC1:18078.1



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Chiocca and Chung

Appl. No.: 09/653,277

Filed: August 31, 2000

For: **Cell-Specific and/or Tumor Specific  
Promoter Retargeting of Herpes  
Gamma 34.5 Gene Expression**

Confirmation No. 4747

Art Unit: 1632

Examiner: Joseph Woitach

Atty. Docket: 0609.4880002/JAG/KRM

**Reply To Restriction Requirement**

Commissioner for Patents  
Washington, D.C. 20231

Sir:

In reply to the Office Action dated May 14, 2002, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group I, represented by claims 1-4<sup>1</sup>, 13-33, and 36. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with** traverse.

MPEP 803 (Eighth Edition, August 2001), at page 800-4, left hand column, states as one of the criteria for a proper requirement for restriction that: "There must be a serious burden on the examiner if restriction is required ...". Thus, the Patent Office encourages the search and examination of an entire application on the merits, where such search and examination can be made *without* serious burden, even though two separate, non-overlapping searches may be required.

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<sup>1</sup>Applicants respectfully request that the Examiner confirm the inclusion of claim 4 in Group I.

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In the present case, Applicants respectfully assert that the search of restriction groups I-III does not impose a serious burden upon the Examiner, as a search concerning the patentability of the invention of one group will clearly uncover art of interest to the other groups. Significantly, the claims of groups I-III have been classified in the *same* class and subclass (435 and 325, respectively), and therefore, can clearly be examined without serious burden on the part of the Examiner. Thus, the claims of Groups I-III should be examined together.

Further, contrary to the Examiner's assertion on page 3, Applicants believe that the claims of inventions I-III are related. The claims are all directed to herpes viral mutants (or methods utilizing said mutants) comprising, at a minimum, a mutation in the gene encoding  $\gamma 34.5$  and an insertion of at least one copy of the  $\gamma 34.5$  gene under the transcriptional control of a cell specific and/ or tumor specific promoter. The claims of Groups II and III have one or more additional modifications to the herpes viral mutant. Applicants direct the Examiner's attention to the Examiner Note in MPEP 808.01, entitled "Unrelated Inventions", which states: "This form paragraph is to be used only when claims are presented to unrelated inventions, *e.g.*, a necktie and a locomotive bearing." Clearly, the claims in this case are related.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

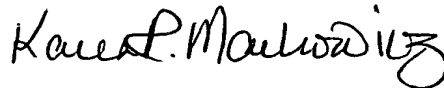
It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of

Chiocca and Chung  
Appl. No.: 09/653,277

time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Karen R. Markowicz  
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Date: 6/10/02

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